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#### **REMARKS**

This Amendment is submitted in response to the Office Action mailed on September 2, 2008. Claims 39 - 47 were pending, and all stand rejected at present. Claims 1 - 38 and 43 - 47 have been cancelled.

#### **ONE SUMMARY OF THE INVENTION**

##### **Brief Summary**

ATMs, Automated Teller Machines, are highly secure devices. The owner of the ATM does not want third parties to gain access to the software which controls the ATM, because such access could allow the third party to take over the ATM.

However, the owner may wish to install an Internet browser within the ATM, for the convenience of customers. The owner may also wish to allow web sites reached by the browser to print advertising for the ATM customer.

A problem arises here because it is common in the Internet world to embed small computer programs within material which a web site sends to a browser. Such programs could hack into the ATM.

To resolve this problem, the invention does not allow the browser to run such programs, or to operate the printer, or other devices. Nor does the invention pass control of the printer to the web site. (Specification, page 17, lines 17 - 25; page 15,

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lines 7 - 9.)

Instead, the invention assigns an Internet address to a component of the ATM, such as a printer. (Specification, page 15, lines 4 - 16; page 18, lines 17 - 23.) This address is different from the address of a browser within the ATM. (Specification, page 15, lines 17 - 20.)

A web site can send a print request to the Internet address of the printer. The request is examined by the software which controls the ATM, and is granted if appropriate.

#### **Summary in Detail**

A bank may operate a self-service terminal (SST), such as an automated teller machine (ATM) 14a in Figure 1. A "Third Party," such as an airline, may wish to present information on the ATM, such as flight schedules or advertising. (Specification, page 1, lines 9, 10; page 3, line 6 et seq.; server 12 in Figure 1 is under control of that third party.)

A web browser 36 in Figure 2, which is within the ATM, gains access to the Internet 16, to thereby reach the server 12, where the advertising/schedules of the airline are stored. (Specification, page 9, lines 12 - 18.)

A user of the ATM has two options: (1) use the ATM as an ATM or (2) use the ATM as a web browser. (Specification, page 11, line 18 - page 12, line 20.) Thus, the web browser function is

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isolated from the ATM functions.

If the user wishes to obtain a print-out of material, such as advertising, obtained from the web site in server 12 in Figures 2 and 4, the web site can send a print request to the ATM 14a. The ATM 14a is assigned an IP address, which is an address on the Internet, similar to a URL, Uniform Resource Locator. For example, the address [www.uspto.gov](http://www.uspto.gov) is a URL.

That IP address at the ATM is termed a "port." When the ATM 14a receives a print request at that "port," a small program, termed a "servlet" executes the printing function. But the ATM software is not involved. (Specification, page 15, lines 4 - 27; page 17, lines 17 - 25.)

**RESPONSE TO ANTICIPATION REJECTION OF CLAIM 39  
BASED ON BARCELOU**

Claim 39 was rejected on grounds of anticipation, based on Barcelou.

Applicant points out that Barcelou, in essence, shows a **single** device which combines (1) an ATM with (2) a generic vending machine. (See column 3, lines 26 - 30. Line 31 et seq. lists the generic vending machine functions.)

Barcelou states that "airline or theatre tickets" can be printed by his device. (Column 4, lines 5, 6.)

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**Re: Claim 39 as Previously Pending**

Point 1

Current claim 39(c), as pending prior to the Office Action,  
stated:

using the terminal application  
to determine if the request  
received from the third party  
application should be granted.

The Office Action cites Barcelou, column 4, lines 8 - 51 to  
show this. However, nothing in this passage of Barcelou shows  
this claim recitation.

-- Lines 8 - 13 merely state that Barcelou's  
invention is significantly different from his  
prior art.

-- Lines 14 - 26 merely assert that  
Barcelou's combination of an ATM and a  
vending machine provide "enormous" "consumer  
appeal."

-- Lines 27 - 39 merely set forth different  
modes of identifying a customer.

-- Lines 40 - 49 merely describe figures  
that show ATMs combined with different  
vending machines.

-- Lines 50 - 51 merely states that the

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different vending machines can be implemented  
using a single video touch-screen.

Therefore, the cited passage of Barcelou fails to show the  
claim recitation in question, which is

-- determining whether the "request" should  
be granted,

-- wherein the "request" is received  
from the "third party application,"

-- and wherein the "determining" is  
done by the "terminal application."

Therefore, Applicant requests, under 37 CFR §§ 1.104(c)(2)  
and 35 U.S.C. § 132, that the PTO **specifically** identify the claim  
recitations in Barcelou.

#### Point 2

Claim 39(d) also recited that control of the printer is not  
passed to the third party application. The Office Action again  
cited the passage of Barcelou which was described immediately  
above.

However, as the description above indicates, Barcelou does  
not show the claim recitation in question. Barcelou fails to  
state that control of the printer is not passed to the  
application.

Applicant requests that this claim recitation be

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**specifically** identified.

Point 3

The claim recitation of Point 2, above, is classified as a so-called "negative limitation."

It could be argued that, if Barcelou says nothing at all about passing control then, therefore, control is not passed as claimed. Stated more simply: the absence of a discussion in Barcelou is said to show the claimed absence.

However, such an argument is insufficient, for the following reasons.

For a reference to be anticipatory under section 102, the reference must be enabling. (See Patents by D. Chisum, sections 3.06(1)(a) and 304(1). See also MPEP § 2121.01.)

For enablement of a negative limitation, the latter must be specifically spelled out in the reference. MPEP § 2173.05(i) states:

Negative Limitations

. . . .

Any negative limitation or exclusionary proviso must have basis in the original disclosure.

. . . .

The mere absence of a positive recitation is not basis for an exclusion. Any claim

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containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement.

Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support.

Therefore, Applicant submits that the hypothetical argument presented at the beginning of this Point 3 must fail.

The mere absence in Barcelou of a discussion that control is not passed as claimed does not show the claimed absence of passing of control.

#### Point 4

Further, the hypothetical argument of Point 3 is actually specious.

As explained above, the claim recitation in question concerns making a determination whether a print request should be granted. If the request is granted, another part of the claim states that control of the printer is not passed to the party making the request.

Therefore, at least these claim elements are present:

- the "request,"
- the "determination" whether to "grant"
- the "request,"

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- if a "grant" occurs, activating the  
"printer," and
- passing no "control" of the "printer" to  
the party making the "request."

The argument is specious because the mere absence of one element (no passing of control) does not show the combination of these elements. All these elements (and others) must be shown in order to anticipate the claim.

#### Interim Conclusion

In view of the discussion above, Applicant submits that Barcelou does not show claim 39 as pending.

#### **Re: Claim 39 as Amended**

Amended claim 39 states that

- the ATM contains a printer,
- the printer is assigned a URL,
- that URL is different from a URL of the  
browser (if any),
- the print request is sent to the URL of  
the printer, and
- control of the printer is not passed to  
the browser.

Applicant sees none of this in Barcelou, and requests that

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these items be identified in Barcelou.

**RESPONSE TO ANTICIPATION REJECTIONS OF REMAINING CLAIMS  
BASED ON BARCELOU**

The discussion of claim 39 applies to these claims.

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**RESPONSE TO ANTICIPATION REJECTION OF CLAIM 39  
BASED ON DRUMMOND**

**Point 1**

Claim 39(c), as pending prior to the Office Action, stated:

using the terminal application  
to determine if the request  
received from the third party  
application should be granted.

Two passages in Drummond are cited to show this:

Passage 1 - column 2, lines 19 - 59;

Passage 2 - column 4, line 60 - column 5, line 14.

Passage 1

Passage 1, lines 19 - 26, posits a need for a device which  
(1) has increased security and (2) markets products to users.  
That fails to show claim 39(c).

The rest of Passage 1, namely, lines 27 - 59, sets forth  
objects of Drummond's invention. Those objects state that a  
financial transaction device is desired which

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- identifies users in specific ways,
- guides the user through transactions, and
- markets products to users.

Plainly, Passage 1 fails to show claim 39(c). Passage 1 fails to show the claimed "determination" of a "request" from a third party.

#### Passage 2

Passage 2 states that ATM 32 in Drummond's Figure 1 can issue other items such as tickets. Passage 2 also states that the ATM 32 contains a display 36, a keypad 38, and a card reader 40.

Plainly, Passage 2 fails to show claim 39(c). Passage 2 fails to show a "determination" made about a "request."

Therefore, Applicant requests that claim 39(c) be **specifically identified** in Drummond.

#### **Point 2**

As explained above, in connection with Barcelou, previous claim 39(d) states that control is not passed to the third party application, but that the third party application gains usage of some peripheral in the ATM.

Drummond, column 14, line 38 - column 15, line 46 is cited to show this claim recitation. However, this passage of Drummond

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fails to do so. Each part of this passage will be described.

-- Column 14, lines 38 - 44, states that, after the customer's transaction has finished, a "thank you" screen is displayed.

-- Column 14, lines 45 - 61, describes behavior of the machine if the customer tarries near the machine, after the transaction.

-- Column 14, line 62 - column 15, line 12 states that, if a customer leaves the machine during a transaction, certain steps are taken to prevent others from stealing the customer's ATM card, cash, etc.

-- Column 15, lines 13 - 30, describes different ways for the customer to input data to the machine.

-- Column 15, lines 31 - 41, states that all inputs may be audible in some cases.

-- Column 15, lines 42 - 46, states that advertising may be selected for display to a customer, based on data stored about the customer.

None of these passages state that (1) a third party obtains services from a peripheral of the ATM but (2) control of the

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peripheral is **not passed** to the third party.

Applicant requests that this claim recitation be **specifically identified** in Drummond.

### **Point 3**

Amended claim 39 states that

- the ATM contains a printer,
- the printer is assigned a URL,
- that URL is different from that of the browser, if any,
- the print request is sent to the URL of the printer, and
- control of the printer is not passed to the browser.

Applicant sees none of this in Drummond, and requests that these items be identified in Drummond.

### **RESPONSE TO ANTICIPATION REJECTIONS OF REMAINING CLAIMS BASED ON DRUMMOND**

The discussion of claim 39 applies to these claims.

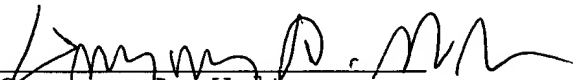
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**CONCLUSION**

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,

  
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Gregory A. Welte  
Reg. No. 30,434

NCR Corporation  
1700 South Patterson Blvd.  
WHQ - 4  
Dayton, OH 45479  
(937) 445 - 4956  
December 2, 2008